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U.S. Application No. 10/026,704 Art Unit 2661
Submission of Amendment with RCE in Response to August 8, 2006 Final Office Action

REMARKS

In response to the final Office Action dated August 8, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 19-31 are pending in this application. Claims 1-18 have been cancelled.

Claims 19-21, 23-28, and 30-31 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Application Publication 2005/0262542 to DeWeese *et al.* Claims 22 and 29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *DeWeese* in view of U.S. Patent 5,548,346 to Mimura *et al.*

The Assignee shows, however, that the pending claims are neither anticipated nor obviated by the cited documents to *DeWeese* and *Mimura*, whether considered alone or in combination. The Assignee thus respectfully submits that the pending claims distinguish over *DeWeese* and *Mimura*.

Rejection of Claims Under 35 U.S.C. § 102 (e)

Claims 19-21, 23-28, and 30-31 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Application Publication 2005/0262542 to DeWeese *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 19-21, 23-28, and 30-31 are not anticipated. These claims recite, or incorporate, features that are not disclosed by *DeWeese*. Independent claims 19 and 30, for example, recite "*a volume of the audio signal is reduced below a volume of the received audible message*

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information being played." Support for such features may be found at least at paragraph [0050] of the as-filed application. Independent claim 19 is reproduced below, and independent claim 30 recites similar features.

19. (Currently Amended) A set top box integrated with, or communicating with, a television, the set top box comprising:

- a first input receiving an audio signal;
- a first output adapted to be received by the television;
- a second output adapted to be received by a second set top box;
- a second input adapted to receive audible message information; and
- a back channel communications path that is different from the first input,

wherein the audio signal is processed for an audio channel and the audible message information is processed for another audio channel and a volume of the audio signal is reduced below a volume of the received audible message information being played.

DeWeese does not anticipate the pending claims. Examiner Van Handel is correct — *DeWeese* discloses how a current TV program's audio may be canceled from chat messages. See U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraph [0109]. The Assignee respectfully asserts, though, that *DeWeese* cancels a program's audio from sent chat messages. When chat messages are recorded by a microphone, the TV program's audio is subtracted from inputs to the microphone. See *id.* at paragraph [0109]. Independent claims 19 and 30, however, recite "*a volume of the audio signal is reduced below a volume of the received audible message information being played.*" Because the patent to *DeWeese et al.* fails to disclose at least these features, the Assignee respectfully asserts that *DeWeese* does not anticipate independent claims 19 and 30. Furthermore, because claims 20-21, 23-28, and 31 depend from either independent claim 19 or 30, these dependent claims incorporate the same distinguishing features. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 19-21, 23-28, and 30-31.

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DeWeese is additionally silent to other claimed features. The patent to *DeWeese et al.* is entirely silent to the “*wherein the audio content is processed for an audio channel and the audible message information is processed for another audio channel.*” Support for such features may be found at least at paragraph [0050] of the as-filed application. Because the patent to *DeWeese et al.* is completely silent to at least these features, *DeWeese* cannot anticipate the claims. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 19-21, 23-28, and 30-31.

DeWeese is additionally silent to other claimed features. Dependent claims 22 and 29 additionally recite “*wherein the audio content is processed for a left audio channel and the audible message information is processed for a right audio channel.*” Support for such features may be found at least at paragraph [0050] of the as-filed application. Because the patent to *DeWeese et al.* is additionally silent to at least these features, *DeWeese* does not anticipate dependent claims 22 and 29.

Claims 19-21, 23-28, and 30-31, then, are not anticipated. The patent to *DeWeese et al.* is completely silent to many features recited in these claims. Because the patent to *DeWeese et al.* fails to disclose so many claimed features, *DeWeese* does not anticipate the claims. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 19-21, 23-28, and 30-31.

Rejection of Claims Under 35 U.S.C. § 103 (a)

Claims 22 and 29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *DeWeese* in view of U.S. Patent 5,548,346 to *Mimura et al.* The features recited in dependent claim 22, however, have been incorporated into independent claim 30. The features recited in dependent claim 29 have been incorporated into independent claim 19. For the following reasons, the proposed combination of *DeWeese* and *Mimura* fails to obviate independent claims 19 and 30.

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1. DeWeese and Mimura Still Fails to Teach or Suggest All Claim Features, so the Prima Facie Case for Obviousness Fails

The proposed combination of *DeWeese* and *Mimura* fails to obviate the claims. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

The *prima facie* case fails. The combined teaching of *DeWeese* and *Mimura* fails to disclose “*a volume of the audio signal is reduced below a volume of the received audible message information being played.*” As the above paragraphs explained, the proposed combination of *DeWeese* and *Mimura* cancels a program’s audio from sent chat messages. When chat messages are recorded by a microphone, the TV program’s audio is subtracted from inputs to the microphone. See U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraph [0109]. Because the proposed combination of *DeWeese* and *Mimura* fails to teach or suggest “*a volume of the audio signal is reduced below a volume of the received audible message information being played,*” as recited in independent claims 19 and 30, one of ordinary skill in the art would not think that these claims are obvious. Examiner Van Handel is thus respectfully requested to remove the § 103 rejections.

2. Because *Mimura* “Teaches Away,” the Proposed Combination of *DeWeese* and *Mimura* Cannot Support a *Prima Facie* Case for Obviousness

Mimura “teaches away” from the proposed combination. “A reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc.*,

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Inc. v. Garlock, Inc., 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” M.P.E.P. at § 2145 (X)(D)(2). **If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case.** See M.P.E.P. at § 2143.01 (emphasis added).

The proposed combination of *DeWeese* and *Mimura* requires an impermissible change to *DeWeese*’s principle of operation. The Office attempts to combine *DeWeese*’s “television chat system” with *Mimura*’s “TV conferencing system.” This proposed combination, however, impermissibly changes *DeWeese*’s principle of operation. As the above paragraphs explained, *DeWeese* cancels a program’s audio from sent chat messages. When chat messages are recorded by a microphone, the TV program’s audio is subtracted from inputs to the microphone. See U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraph [0109]. The patent to *Mimura et al.*, however, teaches how audible signals corresponding to an image may be “presented” or “reproduced” from rear or side wall speakers. U.S. Patent 5,548,346 to *Mimura et al.* (Aug. 20, 1996) at column 14, lines 34-48.

For at least the reasons give above, the Assignee respectfully asserts that *Mimura* “teaches away” from the proposed combination. The only way for *DeWeese* and *Mimura* to reduce “*a volume of the audio signal ... below a volume of the received audible message information being played*,” as independent claims 19 and 30 recite, is to eliminate principle operating aspects of *DeWeese*’s “television chat system.” *DeWeese*’s principle of operation cancels audio by comparing and subtracting a TV program’s audio from a microphone’s input signal. *Mimura*, in contradistinction, reproduces audible signals corresponding to an image from rear or side wall speakers. The proposed combination of *DeWeese* and *Mimura*, then, cannot reduce “*a volume of the audio signal ... below a volume of the received audible message information being played*,” as independent claims 19 and 30 recite, without changing, or even eliminating, *DeWeese*’s principle of operation. Examiner Van Handel is thus respectfully requested to remove the § 103 rejections.

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3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Assignee respectfully asserts that the *prima facie* case for obviousness is defective. A *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the *prima facie* case wholly fails to include any expectation of success. The Office, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

4. There Can Be No Reasonable Expectation of Success, so the Pending Claims Cannot be Obvious

The proposed combination of *DeWeese* and *Mimura* cannot support a reasonable expectation of success. There must be a reasonable expectation of success when combining documents. See M.P.E.P. § 2143. Here, however, the Examiner's *prima facie* case does not have an expectation of success. Because *DeWeese* cancels audio by comparing and subtracting a TV program's audio from a microphone's input signal, one of ordinary skill in the art would not expect success when attempting to combine the teachings of *DeWeese* with the teachings of *Mimura*. *DeWeese* cannot reduce "*a volume of the audio signal ... below a volume of the received audible message information being played,*" as independent claims 19 and 30 recite, and the combined teaching of *Mimura* does not cure this deficiency. One of ordinary skill in the art, then, would not expect success when attempting to combine *DeWeese* and *Mimura* to obviate the pending claims. For at least the reasons give above, the Assignee respectfully asserts that the § 103 (a) rejection of the pending claims should be removed.

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If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@wzpatents.com.

Respectfully submitted,



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